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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,893	07/17/2003	Scott E. Jahns	P-10598.00	1494

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MEDTRONIC, INC.
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EXAMINER

PEFFLEY, MICHAEL F

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,893

Applicant(s)

JAHNS ET AL.

Examiner

Michael Peffley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above claim(s) 51-61 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 12-16, 18-32, 34-41, 43-50 and 62-72 is/are rejected.
- 7) ☒ Claim(s) 9, 11, 17, 33 and 42 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/22/03; 1/31/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

Applicant's election without traverse of the invention of Group I, claims 1-50 and 62-72 in the reply filed on May 18, 2005 is acknowledged.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 29-32, 34, 35, 37, 38, 41, 43, 44, 49 and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Knoepfler (5,209,747).

Knoepfler discloses a device for performing a surgical procedure comprising an elongated handle (10), a pair of closable jaws (34,35) on the distal portion of the handle, means on the handle for delivering ablative energy (see col. 3, lines 12-25), means for closing the jaw including a movable trigger (13), and means for locking the trigger in place (15,16,17). The locking means comprises a slide (i.e. elements 15 and 16 slide relative to one another) and a plurality of locking teeth (17). It is noted that between

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each tooth is a space that could be deemed a detent into which a matching tooth is locked. Regarding the closure of the jaws, handle (13) actuates a tensioning cable (41), which cable resides in tube (11) of the device. The trigger pivots upwards towards the handle (i.e. tube 10) when the jaws are opened, and the jaws may be closed on tissue in a straight configuration. There is a spring means (46,47) coupled to the trigger which limits the force applied to tissue by the jaws. Also, there is a fluid channel (65) which may provide ablative treatment (i.e. laser fiber) as well as irrigation and suction. Knoepfler also specifically discloses that an electrode may serve as the ablative means (col. 3, lines 21-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10, 12-14, 16, 27, 28 and 62-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morley et al (6,685,698) in view of the teaching of Knoepfler (5,209,747).

Morley et al discloses a surgical clamping device that includes means to control the pitch and roll of the clamping device. The device includes a handle (14.1) with a pair of jaws (13,11) attached to the distal end. Various cable means are provided for controlling the opening/closing of the jaws, as well as for controlling the pitch and roll (i.e. position) of the jaws relative to the handle (see Figures 5-17). The cables allow for

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individual (i.e. manual) control of the operation of the jaws, pitch and roll (see Figures and column 3). The handle includes a proximal longitudinal axis (14.1) and a distal longitudinal axis (24) that is laterally offset from the proximal longitudinal axis. Morley et al fail to disclose providing an ablative element (i.e. electrode) on the jaws to treat tissue as it is being grasped.

As addressed previously, Knoepfler disclose a surgical tool including grasping jaws very much like the Morley et al device. Knoepfler further discloses controlling the angle of the jaws for treating hard to reach tissue. Knoepfler specifically disclose that it is generally known to provide such a surgical tool with an electrode (col. 3, lines 21-27) to provide energy to tissue as it is being treated.

To have provided the Morley et al device with an electrode to allow for ablative treatment of tissue while it is being grasped would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Knoepfler.

Claims 1-8, 10, 12-14, 16, 18-21, 27, 28, 62-68, 70 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knoepfler ('747) in view of the teaching of Morley et al ('698).

The Knoepfler device has been previously addressed. Knoepfler discloses a device substantially as set forth in the claims, but fails to provide a control means to adjust both the pitch and the roll of the forceps jaws. Rather, Knoepfler discloses means to adjust only the pitch of the forceps jaws.

Morley et al, as previously discussed, teach that it is known to provide laparoscopic grasping devices with a means to control both the pitch and the roll of the distal end effectors.

The examiner maintains that it would have been an obvious modification for one of ordinary skill in the art to have provided the Knoepfler device with a means to control both the pitch and the roll of the end-effectors to allow for more accurate placement at a tissue site in view of the teaching of Morley et al.

Claims 14, 15 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knoepfler ('747) and Morley et al ('698), and further in view of the teaching of Mulier et al (6,440,130).

The combination of the Morley et al teaching with the Knoepfler device has been previously addressed. While Knoepfler and Morley et al both disclose endoscopic jaws for grasping tissue, neither one specifically discloses forming the jaws of a malleable material to allow shaping of the jaws.

Mulier et al disclose another endoscopic grasping device that includes jaws having electrodes thereon for grasping and electrosurgically treating tissue. In particular, Mulier et al teach that it is advantageous to form the jaws of a malleable material (see claim 7) which enables the jaws to be formed into a desired shape for treatment of tissue.

To have made the Knoepfler jaws from a malleable material to enable shaping of the jaws to fit a particular tissue site would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Mulier et al.

Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knoepfler ('747) and Morley et al ('698), and further in view of the teaching of Riza (5,480,409).

Again, the combination of the Morley et al teaching with the Knoepfler device has been addressed. While Knoepfler provides a trigger mechanism for actuating the jaws similar to that disclosed by the applicant, there is no specific teaching in Knoepfler of providing a spring means for limiting the force applied by the jaws, and no teaching of using a link-arm to control the jaw movement.

Riza discloses another endoscopic device for grasping and electrosurgically treating tissue. In particular, Riza teaches that it is known to provide the trigger mechanism with a spring means (77) coupled to the trigger to limit the force applied by the jaws and to maintain the jaws in a normally open position. Also, Riza provides a link-arm (83,84) that affords control of the jaw closure (i.e. by allowing the jaws to be locked in progressively closed positions).

To have provided the Knoepfler device with a trigger mechanism that includes a spring means and a link-arm means to more accurately control the operation of the jaw members would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Riza.

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Claims 25, 26 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knoepfler ('747) and Morley et al ('698), and further in view of the teaching of Bauer (4,128,099).

Knoepfler and Morley et al both disclose endoscopic forceps jaws whereby closure of the jaws is effected through movement of both jaws through a central pivot. The examiner maintains that it is generally well-known in the art to provide forceps that operate by moving either one or both jaws. Bauer discloses one such electrosurgical forceps device whereby one jaw is stationary and one jaw is movable to grasp tissue.

To have provided the Knoepfler device, as modified by the teaching of Morley et al, with a single movable jaw for grasping tissue would have been an obvious design alternative for one of ordinary skill in the art, particularly since Bauer teaches that it is known to provide forceps jaws with a single movable jaw.

Claims 36 and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knoepfler ('747) in view of the teaching of Riza (5,480,409).

Knoepfler fails to disclose a spring means attached to the trigger, or a link-arm for controlling closure of the forceps jaws.

Riza discloses another endoscopic device for grasping and electrosurgically treating tissue. In particular, Riza teaches that it is known to provide the trigger mechanism with a spring means (77) coupled to the trigger to limit the force applied by the jaws and to maintain the jaws in a normally open position. Also, Riza provides a

link-arm (83,84) that affords control of the jaw closure (i.e. by allowing the jaws to be locked in progressively closed positions).

To have provided the Knoepfler device with a trigger mechanism that includes a spring means and a link-arm means to more accurately control the operation of the jaw members would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Riza.

Claims 39 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knoepfler ('747) in view of the teaching of Mulier et al. (6,440,130).

Knoepfler fails to disclose malleable forceps jaws that may be formed into a desired shape for a particular treatment site.

Mulier et al disclose another endoscopic grasping device that includes jaws having electrodes thereon for grasping and electrosurgically treating tissue. In particular, Mulier et al teach that it is advantageous to form the jaws of a malleable material (see claim 7) which enables the jaws to be formed into a desired shape for treatment of tissue.

To have made the Knoepfler jaws from a malleable material to enable shaping of the jaws to fit a particular tissue site would have been an obvious modification for one of ordinary skill in the art in view of the teaching of Mulier et al.

Claims 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knoepfler ('747) in view of the teaching of Bauer (4,128,099).

Knoepfler discloses forceps jaws whereby the tensioning wire actuates both jaws simultaneously to grasp tissue.

The examiner maintains that it is generally well-known in the art to provide forceps that operate by moving either one or both jaws. Bauer discloses one such electrosurgical forceps device whereby one jaw is stationary and one jaw is movable to grasp tissue.

To have provided the Knoepfler device with a single movable jaw for grasping tissue would have been an obvious design alternative for one of ordinary skill in the art, particularly since Bauer teaches that it is known to provide forceps jaws with a single movable jaw.

Allowable Subject Matter

Claims 9, 11, 17, 33 and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

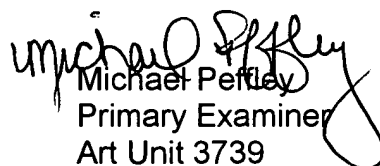
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wallace et al (6,312,435), Grace (6,132,441) and Nicholas et al (5,514,157) disclose various other endoscopic graspers with means to adjust the alignment of the jaw members.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (571) 272-4770. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michael Peffley
Primary Examiner
Art Unit 3739

mp
July 12, 2005